

REMARKS/ARGUMENTS

Claims 1-21 are a part of this application.

Claims 1-14 have been rejected.

Claim 2 has been objected to.

Claims 15-21 have previously been withdrawn. Applicant affirms the election of claims 1-14 for prosecution in this application.

I. Objections

Claim 2 has been objected to under 37 CFR § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 2 has been amended herein to recite that the organic film is a plastic film. As amended, claim 2 is in proper dependent form in conformance with 37 CFR § 1.75(c). This rejection is now moot and should be withdrawn.

II. Rejections Under 35 USC § 102

A. First Rejection under 35 USC § 102(e)

Claims 1, 2 and 6-14 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. US 2002/160151 to Pinault et al. (hereafter "*Pinault*"). The Examiner asserts that *Pinault* discloses "an integrated granule product that includes a film having granules."

Anticipation requires the presence, in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. (*Richardson v. Suzuki Motor Co.*, 8 USPQ2d 1913, 1920 (Fed. Cir. 1989)). *Pinault* teaches an integrated granule product that

is generally considered to be an intermediate product because it is suitable for application onto various substrates for end use applications. According to the teaching in *Pinault*, the integrated granule product 10 may be received upon an asphalt based substrate 20. (emphasis added).

Pinault, however, does not teach an impact resistant roofing shingle comprising a substrate having an exposed and unexposed surface and coated on both surfaces with asphalt and wherein said exposed surface is layered with granules and said unexposed surface is laminated to an organic film. (emphasis added).

Furthermore, unlike the integrated product in *Pinault*, which uses a cured adhesive 14 to adhere granules 16 to a film 12 (i.e. the exposed surface of the film), amended claim 1 recites an adhesive on the unexposed surface of the substrate which is laminated to an organic film.

Accordingly, *Pinault* does not teach each and every element of amended claim 1 arranged as in the claim, and as such, claim 1 is not anticipated. Since claims 2-14 depend directly or indirectly from amended claim 1, these claims incorporate all the limitations of claim 1 are likewise not anticipated for the same reasons as asserted with regard to claim 1.

B. Second Rejection Under 35 USC § 102(e)

Claims 1-4, 6, 7 and 9-14 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. US 2002/0110679 to Miller et al. (hereafter "*Miller*"). The Examiner asserts that *Miller* discloses a "storm proof asphalt-based roofing material" which "includes a substrate coated with an asphalt coating, a protective coating, a layer of granules, and a web bonded to the lower region of the asphalt coating.

Unlike the impact resistant roofing shingle of amended claim 1, *Miller*, does not teach such a shingle comprising a substrate having an exposed and unexposed surface and coated on

both surfaces with asphalt and wherein the exposed surface is layered with granules and the unexposed surface includes an adhesive layer which is laminated to an organic film. Rather, *Miller* teaches a protective coating on the upper surface of the asphalt coating and upon which granules are applied. (emphasis added) In the invention recited in amended claim 1 of the present application, the adhesive is coated on the asphalt on the unexposed (lower) layer of the substrate and which is laminated to an organic film, not to granules.

Accordingly, *Miller* does not teach each and every element of amended claim 1. Specifically, *Miller* does not teach an adhesive layer coated on the asphalt on the unexposed surface of the substrate and which is laminated to an organic film. In view of this, claim 1 is not anticipated. Since claims 2-4, 6, 7 and 9-14 depend directly or indirectly from amended claim 1, these claims incorporate all the limitations of claim 1 are likewise not anticipated for the same reasons as asserted with regard to claim 1.

C. Rejection Under 35 USC § 102(b)

Claims 1-7 and 9-14 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 4,636,414 to Tajima, et al. (hereafter "*Tajima*"). In the Office Action, the Examiner states that *Tajima* discloses "a laminate bituminous roofing membrane" that "includes a fibrous sheet, a first bituminous layer laminated on one surface of the fibrous sheet, the bituminous layer being composed of bitumen or a bituminous mixtures, a synthetic resin sheet or film laminated on the other surface, and a mineral aggregate layer deposited on the surface."

Unlike the impact resistant roofing shingle of amended claim 1, *Tajima*, does not teach such a shingle comprising a substrate having an exposed and unexposed surface and coated on both surfaces with asphalt and wherein the exposed surface is layered with granules and the

unexposed surface includes an adhesive layer which is laminated to an organic film. The Examiner states that the "bituminous layers can be applied or bonded to a substrate by using adhesives such as rubber-modified bitumen (col 5, ln 43-57). The application of the adhesive in *Tajima*, however, is for ready application at a construction site. On the contrary, the adhesive in amended claim 1 is applied on the asphalt layer on the unexposed surface of the substrate and is laminated to the organic film.

Accordingly, *Tajima* does not teach each and every element of amended claim 1. Specifically, *Tajima* does not teach an adhesive layer coated on the asphalt on the unexposed surface of the substrate and which is laminated to an organic film. In view of this, claim 1 is not anticipated. Since claims 2-7 and 9-14 depend directly or indirectly from amended claim 1, these claims incorporate all the limitations of claim 1 are likewise not anticipated for the same reasons as asserted with regard to claim 1.

III. Conclusion

In view of the aforementioned remarks and amendments, the Applicants believe that each of the pending claims is in condition for allowance and respectfully requests the withdrawal of all rejections to the claims. If, upon receipt and review of this amendment, the Examiner believes that the present application is not in condition for allowance and that changes can be suggested which would place the claims in allowable form, the Examiner is respectfully requested to contact Applicant's undersigned counsel at the number provided below.

Appl. No. 10/734,788
Amdt. dated June 29, 2005
Reply to Office Action of May 20, 2005

Please charge any additional fees that may be due, or credit any overpayment of same, to
Deposit Account No. 50-1855.

Respectfully submitted,

Date: June 29, 2005



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